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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,454	06/28/2001	Ramin Amin- Sanaye	IR3569NP-PC1	4197

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EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,454

Applicant(s)

Amin-Sanayei et al

Examiner

T. Yorn

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 6-25-03

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-22 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-3 and 5-22 is/are rejected.
- ☒ Claim(s) 4 is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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Even though applicant fails to recite that the substitute specification does not contain New matter, the recitation that the substitute specification is identical to the corresponding above-identified application as originally filed would be sufficient. Also, said substitute specification is the published document, WO 01/34670 A1.

Spelling correction of "2,5-dimethythexyl" in line 10, page 7 to "2,5-dimethylhexyl" has been made.

The recited "wherein a) and b), if present, are present in a combined amount of at least 80 mol% in claim 1 would be reasonably supported by the teaching at page 5, lines 2-16.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-3 and 5-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0 544 233.

EP teaches a fluorine-containing copolymer comprising 10 to 80 mol% of a fluoroolefin and 2 to 70 mol% of an organosilicon compound in abstract and at page 2. The instant polymerizable sterically hindered organosilicon compounds such as vinyltris(methoxyethoxy)silane are taught at page 4, lines 6-15. The formula (II) in claims 6-8 is an optional.

Thus, the instant invention lacks novelty.

Claims 1-3, 5-17 and 20-22 are rejected under 35 U.S.C. 103(a) as obvious over EP 0 544 233 in view of Kobayashi et al (US 5,859,123).

The instant invention further recites other polymerizable sterically hindered organosilicon compounds, metal oxide, other monomer and a method of polymerization over EP. However, EP teaches employing a pigment at page 5, lines 1 and 4, and thus the use of TiO_2 (white pigment) which inherently reacts with silane group of fluoro-copolymer in EP to obtain white color would be obvious. Example 1 of EP also teach employing other monomers such as vinyl butyrate or vinyl ether (page 5, lines 20-21).

Kobayashi et al teach various sterically hindered organosilanes and functional substituents at col. 3, lines 21-63, and the use of a pH buffer at col. 6, lines 1-17.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize TiO_2 (white pigment) which inherently reacts with silane group of fluoro-

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copolymer having 80 mol% of a fluoroolefin in EP to obtain white color and to utilize other sterically hindered organosilanes and/ or a pH buffer of Kobayashi et al in EP since the alkoxy groups (page 4, line 6) taught by EP encompass an isopropoxy or ter-butoxy group (col. 3, lines 23-26) of Kobayashi et al and since EP teaches various polymerizations at page 4, lines 29-43 absent showing otherwise.

Claims 1-3 and 5-22 rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 544 233 in view of Kobayashi et al (US 5,859,123), and further in view of Maruyama et al (US 5,973,090) and Charleux et al (US 6,353,065).

The instant claim 18 further recites other compounds and steps over EP and Kobayashi et al. However, Maruyama et al teach such limitation at col. 4, lines 8-28 and 41-50, and Charleux et al teach disodium phosphate at col. 10, lines 45-50.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the art well known buffer agent, disodium phosphate, of Charleux et al and polymerization system of Maruyama et al in EP and Kobayashi et al thereof since EP teaches various polymerizations at page 4, lines 29-43 and since Charleux et al teach and equate said disodium phosphate and potassium carbonate (of Kobayashi et al) and since Maruyama et al teach the use of any polymerization method at col. 4, lines 8-14.

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Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

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Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/July 15, 2003



TAE H. YOON
PRIMARY EXAMINER